



Atty. Dkt. No. 040405-0320

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8-19-03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Toshio NITTA

Title: METHOD OF TRANSMISSION FROM TCP/IP
COMMUNICATION NETWORK TO MOBILE
COMMUNICATION NETWORK AND TRANSMISSION AND
RECEPTION SYSTEM THEREFOR

Appl. No.: 09/589,086

Filing Date: 06/08/2000

Examiner: Unknown

Art Unit: 2731

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INFORMATION DISCLOSURE STATEMENT
UNDER 37 CFR § 1.56

Mail Stop PATENT APPLICATION
Commissioner for Patents
PO Box 1450
Alexandria, Virginia 22313-1450

Sir:

Submitted herewith on Form PTO/SB/08 is a listing of documents known to Applicant in order to comply with Applicant's duty of disclosure pursuant to 37 CFR § 1.56. A copy of each listed document is being submitted to comply with the provisions of 37 CFR § 1.97 and § 1.98.

The submission of any document herewith, which is not a statutory bar, is not intended as an admission that such document constitutes prior art against the claims of the present application or that such document is considered material to patentability as defined in 37 CFR § 1.56(b). Applicant does not waive any rights to take any action which would be appropriate to antedate or otherwise remove as a competent reference any document which is determined to be a *prima facie* art reference against the claims of the present application.

TIMING OF THE DISCLOSURE

The listed documents are being submitted in compliance with 37 CFR §1.97(b), before the mailing date of the first Office Action on the merits.

RELEVANCE OF EACH DOCUMENT

The foregoing documents were cited by the examiner in Applicant's corresponding Swedish application.

A translation of a portion of a Swedish Office Action that issued on March 19, 2003 with respect to a counterpart Swedish patent application is provided below.

Cited references

WO 9716007 (called D1 below)
EP 0812085 (called D2 below)
US 5,130,129 (called D3 below)
JP 5207072 (called D4 below)

D1 discloses communication between a packet switching computer network and a network for telephone communication which can be mobile.

In the gateway between the two protocols the head of the packet is adapted such, that it can be applied in the second protocol. Calls are connected from the TCP/IP communication network to the network for mobile communication. The gateway has a signal interface on the one hand towards the network for TCP/IP communications and on the other hand towards the network for mobile communication. In the gateway IPC addresses are converted to telephone numbers. The conversion is carried out by means of a data base or a table which preferably is located in the gateway. In the table IP addresses and their corresponding telephone numbers are listed in pairs. The gateway hereafter sets up the connection. A connection between the terminal on the network side of TCP/IP and the gateway is set up, a connection between the gateway and the side of the mobile communication is set up and also the call. The gateway sets up the call by means of the telephone number. See page 7, line 9 – page 8, line 9; page 9, lines 4-24; page 11, lines 10-16; Claims 9, 11, and 14, respectively.

Claim 5 of D1 discloses providing a circuit for allowing the set up of calls to be implemented using the TCP/IP protocol. Claim 6 also discloses this but using DSS#2 signaling. Setting up calls can also be carried out by means of TUP/ISUP signaling.

In D3 a call is automatically initiated, see the Abstract; column 1, lines 34-38 and lines 53-56; column 2, lines 50-55; column 3, lines 13-18; and column 5, lines 4-7. See also Claims 1-4 in D4.

D1 is considered to represent the most relevant known technology. The measure of, as disclosed in the submitted Claims 1 and 11, receiving an IP packet from a TCP/IP communication network, extracting an IP address from this packet, converting this address to a telephone number in the receiving mobile communication network by means of a table, and thereafter calling this number in the mobile network is deemed to be lying close at hand to the subject matter of D1. The difference between D1 and the submitted Claims 1 and 11 is that the submitted claims disclose that an originating signal and a selection signal based on the telephone number that has been found are sent. This difference is not deemed to contain inventive merit as this is well-known technology, see D3 and D4, in which automatic connection is carried out. Claims 1 and 11 are therefore deemed not to be patentable.

Submitted Claim 2 includes a time-division switch, a device for extracting an IP address and finding its corresponding telephone number, sending originating and selection signals, circuits for detecting these signals and a device for sending these signals. Against the background of what is shown by D1 the above seem to be obvious features within the field of knowledge of a person skilled in the art of connecting a call automatically. This is therefore considered to be obvious and hence not patentable.

The invention of Claim 3 is obvious on the basis of the disclosure of D1. In Claim 3 well-known technology is utilized, said technology for example being known from 02 which explicitly states that circuits for terminating processes are utilized. In TCP/IP communication the pattern of synchronous characters is usually read out in order to find the first IP packet. Hence, Claim 3 is not patentable.

Claim 4 is considered also to be obvious in view of D1 as D1 also shows tables.

Claims 7 and 8, respectively, which are dependent of Claim 4, solely disclose embodiments being obvious to a person skilled in the art and can therefore not be utilized as the basis of patent protection. This also applies to Claims 5, 6, 10, 12 and 13, respectively, which solely disclose well-known features in the relevant field of technology.

The invention of Claims 9 and 14, respectively, in which communication is carried out from the mobile network to the TCP/IP network, may be found in D1, see for example page 4, lines 26-31 and Claim 9, and are therefore not patentable.

Applicant respectfully requests that any listed document be considered by the Examiner and be made of record in the present application and that an initialed copy of Form PTO/SB/08 be returned in accordance with MPEP §609.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 CFR §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741.

Respectfully submitted,

Date: August 11, 2003

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Substitute for form 1449B/PTO

**INFORMATION DISCLOSURE
STATEMENT BY APPLICANT**

Date Submitted: August 11, 2003

(use as many sheets as necessary)

Sheet 1 of 1

Complete if Known

Application Number	09/589,086
Filing Date	06/08/2000
First Named Inventor	Toshio NITTA
Group Art Unit	2731
Examiner Name	Unknown
Attorney Docket Number	040405-0320

U.S. PATENT DOCUMENTS

Examiner Initials*	Cite No. ¹	U.S. Patent Document		Name of Patentee or Applicant of Cited Document	Date of Publication of Cited Document MM-DD-YYYY	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear
		Number	Kind Code ² (if known)			
	C1	5,131,029		KUNSTADT	07-14-1992	

FOREIGN PATENT DOCUMENTS

Examiner Initials*	Cite No. ¹	Foreign Patent Document			Name of Patentee or Applicant of Cited Documents	Date of Publication of Cited Document MM-DD-YYYY	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear	T ⁶
		Office ³	Number ⁴	Kind Code ⁵ (if known)				
	C2	EP	0 812 085	A1	NTT MOBILE COMMUNICATIONS NETWORK INC.	12-10-1997		
	C3	WO	97/16007		TELECOM FINLAND OY	05-01-1997		
	C4	JP	5-207072		NEC CORPORATION	08-13-1993		A

NON PATENT LITERATURE DOCUMENTS

Examiner Initials*	Cite No. ¹	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.) date, page(s), volume-issue number(s), publisher, city and/or country where published.	T ⁶

Examiner Signature

Date Considered

*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

¹ Unique citation designation number. ² See attached Kinds of U.S. Patent Documents. ³ Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). ⁴ For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document.

⁵ Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST. 16 if possible. ⁶ Applicant is to place a check mark here if English language Translation is attached.

Burden Hour Statement: This form is estimated to take 2.0 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, PO Box 1450, Alexandria, Virginia 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, PO Box 1450, Alexandria, Virginia 22313-1450.